IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: JOHN P. RUCKART)
)
SERIAL NO.: 10/086,338)   ART UNIT:
)   2614
FILED: March 1, 2002)
)   EXAMINER:
FOR: TELEPHONE HOLD FEATURE)   Lisa Hashem

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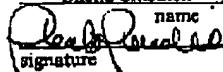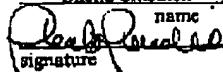
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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

In response to the Final Office Action mailed June 15, 2006, and in conjunction
with the concurrently filed Notice of Appeal, Applicants request a pre-Appeal conference
in view of the following remarks.

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REMARKS

In response to the Office Action dated June 15, 2006, Applicant respectfully requests reconsideration based on the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Prior to discussing the rejection, a brief description of embodiments is presented. Embodiments allow a user to automatically place calls on hold without user interaction. The user can specify a schedule of time during which calls are to be placed on hold. The user may also specify calling parties for whom calls are to be placed on hold. Support for these features are found in at least paragraphs [0047] and [0049] of Applicant's specification. It is also important to note that calls placed on hold may subsequently be placed into voicemail as shown in Applicant's Figure 5. The voicemail feature is present in claims 10 and 13 and clearly indicates that the hold function and the voicemail function are separate processes. This is relevant as the meaning of "hold" versus "voicemail" has been distorted by the Examiner in the rejection of the claims.

Claims 6-10, 12, 13 and 17-22 were rejected under 35 U.S.C. § 103 as being unpatentable over Novak in view of Dutta. This rejection is traversed for the following reasons.

Claim 6 recites, *inter alia*, "automatically answering the call if the call corresponds to the one or more parameters of the hold function and placing the call on hold; playing a message to the calling party that the call has been placed on hold; and connecting the called party to the calling party when the called party answers the call." Claim 6 defines a hold system. Novak is not a hold system, but rather a voice mail system. Depending on the caller or the time, Novak teaches either placing the call into voicemail or processing the call in a normal fashion. There is no hold function in Novak.

The Examiner's statement that "Novak clearly discloses placing an incoming call on hold prior to being answered" is incorrect. As used in this application, and as known in the art, hold and voicemail are two different functions. These functions are know to users of telephony and are described in Applicant's specification. For the Examiner to equate the voicemail system of Novak with the hold system of claim 6 is to ignore the plain meaning of the terms "hold" and "voicemail". These functions are not equivalent, and thus Novak cannot be construed as teaching placing incoming calls on hold.

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The Examiner relies on Dutta for disclosing placing a call on hold based on certain parameters, but this fails to cure the deficiencies of Novak. Dutta is directed to sending commands to phones to place calls on hold automatically. For example, in a theater, a command may be sent to all phones to force incoming calls on hold to prevent disruption of the patrons. Novak is directed to placing calls into voicemail, not to a hold function. The hold features of Dutta would not be applicable to the system of Novak. In particular, the designation of times and callers to place in hold is not taught by either Novak or Dutta. Even if Novak and Dutta are somehow combined, the features of claim 6 do not result.

For at least the above reasons, claim 6 is patentable over Novak in view of Dutta. Claims 7-10, 12, 13, and 21 depend from claim 6 and are patentable over Novak in view of Dutta for at least the reasons advance with respect to claim 6.

The misinterpretation of "hold" versus "voicemail" is clearly apparent in the Examiner's analysis of claims 10 and 13, which recite voicemail functions, in addition to the hold function of claim 6. With respect to claims 10 and 13, the Examiner now considers Novak to be a voicemail system, whereas with respect to claim 6, Novak teaches a hold system. Clearly, Novak discloses a voicemail system, not a hold system as recited in claim 6 or a combined hold and voicemail system as recited in claims 10 and 13. Thus, the rejection is improper.

Independent claim 17 recites features similar to those discussed with reference to claim 6. Thus, claim 17 is patentable over Novak in view of Dutta. Claims 18-20 and 22 depend from claim 17 and are patentable over Novak in view of Dutta for at least the reasons advanced with respect to claim 17.

Claim 11 was rejected under 35 U.S.C. § 103 as being unpatentable over Novak in view of Dutta and Okun. This rejection is traversed for the following reasons.

Okun was relied upon for disclosing a message resident on a service node of a telecommunication network, but fails to cure the deficiencies of Novak in view of Dutta discussed above with reference to claim 6. Claim 11 depends from claim 6 and is patentable over Novak in view of Dutta and Okun for at least the reasons advance with reference to claim 6.

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Claims 14-16 were rejected under 35 U.S.C. § 103 as being unpatentable over Okun in view of Novak. This rejection is traversed for the following reasons.

Claim 14 recites, *inter alia,* "the determining based on at least one of a schedule including at least one time period during which the incoming call is placed on hold, and a list including at least one potential calling party from whom incoming calls are placed on hold." As noted by the Examiner, Okun fails to teach placing a caller on hold based on these parameters. In Okun, the called party places the call in hold by pressing a button. Novak is directed to a voicemail system that places callers into voice mail based on the caller's identity or a schedule. Novak does not teach placing callers on hold. Thus, even if Okun and Novak are combined, the logical combination would be to use the hold features of Okun with the voice mail features of Novak. There is no teaching or suggestion in either reference to modify the hold features of Okun.

For at least the above reasons, claim 14 is patentable Okun in view of Novak. Claims 15 and 16 depend from claim 14 and are patentable over Okun in view of Novak for at least the reasons advanced with respect to claim 14.

In view of the foregoing remarks and amendments, Applicant submits that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130.

Respectfully submitted,

By: _____
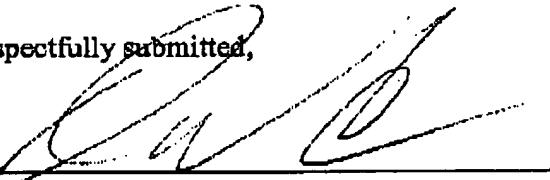
David A. Fox
Registration No. 38,807
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No. 36192

Date: September 15, 2006